

### **REMARKS**

Pursuant to the present amendment, claims 66 and 81 have been amended and new claims 85-87 have been added. Thus, claims 1, 2, 4, 6-9, 11-14, 16-19, 21, 22, 24-30 and 66-84 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested.

#### **I. Initial Matters**

In the Office Action, claims 1, 2, 4, 6-9, 11-14, 16-19, 21, 22 and 24-30 were allowed.

#### **II. Non-Prior Art Matters**

The Examiner objected to the specification on the basis that the term “end face” is not found in the specification. Additionally, claims 66-84 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully disagrees.

As the Examiner well knows, there is no requirement that the precise words used in the claims be found in the specification. All that is required is that the claimed invention must be fully supported by the application as filed, including the drawings. Attached is a marked-up version of Figure 2 of the present application clearly showing the “end face” of the second end of the valve stem 20 (the first end of the valve stem 20 is operatively coupled to the gate 16). The specification clearly describes that the bonnet cap 26 and the seals 103, 104, 106 define a sealed cavity 112. See, *e.g.*, specification at p. 11, ll. 2-21 and p. 12, l. 19 – p. 13, l. 6. Figure 2 also contains a reference number (circled) that clearly shows that this cavity 112 exists above the end face of the valve stem 20. The cavity 112 may include more than just the area above the end face, as indicated by the additional reference numbers 112. The threaded connection between the

valve stem 20 and the roller screw assembly 24 will allow the pressure of the working fluid to exist in the portion of the cavity 112 above the end face of the second end of the valve stem 20.

It is also interesting to note that, in making the rejections based upon Nelson, the Examiner made reference to an “end face” that is disclosed in Nelson. Office Action, p. 3. However, the undersigned has reviewed the disclosure of Nelson and cannot find where the term “end face” is used in Nelson. This is evidence that the specification does not need to contain specific words in order to be understood – it is not an ipsis verbis test.

For the aforementioned reasons, it is respectfully submitted that the rejection under 35 U.S.C. § 112 be withdrawn. The application, as filed, clearly reflects that the inventor had possession of the claimed invention.

As to the objection to the specification, should the Examiner believe that the specification should be amended, Applicant will amend the specification to expressly recite the term “end face” such that the specification is in conformance with what is shown in the drawings. Applicant does not believe that such an amendment is required, but will do so if requested by the Examiner.

### **III. Prior Art Rejections**

In the Office Action, claims 66-72, 74-78 and 80-84 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Nelson (U.S. Patent No. 3,770,247). Applicants respectfully traverse the Examiner’s rejections.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency

requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgirg v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing prima facie anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

Pursuant to the present amendment, independent claim 66 has been amended to recite that the valve stem is solid, *i.e.*, it does not have any opening formed in the valve stem. This clearly distinguishes Nelson from the invention set forth in claim 66. Thus, the Examiner’s anticipation rejection of claims 66-74 should be withdrawn for at least this reason. Additionally, it should be noted that there is no motivation or suggestion in Nelson to locate the opening 96 in Nelson in any place other than through the stem shown therein.

It is believed that the Examiner’s rejections of claims 75-80 is based upon an inadvertent misreading of what is claimed. Independent claim 75 specifically recites that the device comprises “an opening formed in said bonnet...” (emphasis added). In the Office Action, the Examiner stated that various structures “extend ‘through’ them as claimed.” Office Action, p. 3.

It is clear that independent claim 75 requires that the opening be formed in the bonnet. Nelson does not disclose or suggest such a configuration. Accordingly, it is respectfully requested that the anticipation rejection of claims 75-80 be withdrawn.

Pursuant to the present amendment, independent claim 81 has been amended to clearly recite that the opening is formed in the body of the device. As thus amended, it is respectfully submitted that claims 81-84 are allowable. Nelson does not disclose or suggest such a configuration.

#### **IV. New Dependent Claims 85-87**

Pursuant to the present amendment, new dependent claims 85-87 have been added to further define the Applicant's invention. Claims 85, 86 and 87 depend from, respectively, independent claims 66, 75 and 81. Each of these claims recite that when the valve is placed in service, the pressure of the working fluid exerted on the entirety of the end face substantially balances pressure forces acting on the valve stem. Support for the amendment can be found in the specification at, for example, p. 12, l. 19 – p. 13, l. 1 and p. 16, ll. 16-24. Claims 86 and 87 do not include the reference to a solid valve stem.

New dependent claims 85-87 are allowable over the art of record. Nelson certainly does not disclose a device like that described in claims 85-87. Attached is a marked-up version of Nelson indicating that the device does not achieve substantial pressure balancing as set forth in dependent claims 85-87.

It is clear that the diameter "A" of the end face "B" of Nelson is significantly smaller than the diameter "C" of the valve stem below the seal "D" disclosed therein. Thus, if the same pressure exists within the body of the valve and in the cavity above the end face B in Nelson, there will be a net upward force (indicated by the arrow "E") due to the different cross-sectional

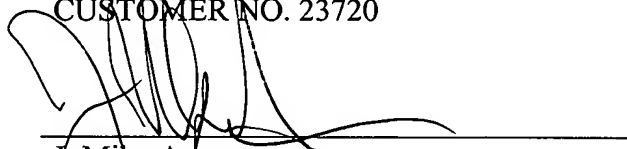
areas exposed to the working pressure. Thus, the device in Nelson does not substantially balance the pressure forces acting on the stem. Accordingly, it is respectfully submitted that claims 85-87 are also allowable over the art of record.

**V. Conclusion**

In view of the foregoing, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'J. Mike Amerson', is written over a horizontal line.

Date: December 22, 2005

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